

REMARKS

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks, which place the application in condition for allowance.

I. STATUS OF CLAIMS

Claims 1-5 and 11 are pending in this application. Claims 6-10 have been cancelled and claim 1 amended. No new matter has been added by these amendments.

II. THE 35 U.S.C. 102/103 REJECTIONS

The office action rejects claims 1-6 and 8 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,376,205 to Drake ('205 Drake) and 1-6 and 8-10 as anticipated by U.S. Patent No. 4,934,740 also to Drake ('704 Drake). Finally, the office action rejects claim 9 under 35 U.S.C. § 103(a) as unpatentable over the either of the Drake patents in view of U.S. Patent No. 3,334,921 to Fischer.

Claim 1 has been amended to recite among other things, "said note pad is formed with a pen-receiving hole that extends through said stub portions of said note sheets and at least said top lateral portion of said panel." The Examiner asserts that the binder holes shown in '205 Drake could be utilized for this purpose. While the Examiner's assertions are debatable, as there is no teaching of such use, and since a specific use allowing the passage of binder rings through such holes is provided for, there is no teaching of a device having a hole through a panel and stub portions for the insertion of a pen as recited in amended claim 1. As to the combination of either of the Drake references with Fisher which the Examiner asserts teaches a panel, it does not, however, provide for a hole in the panel for insertion of a pen. Moreover, the holes asserted by the Examiner for the binding rings in '205 Drake could not be used in combination with the hole-less cover of Fisher to allow for the insertion of a pen. Such binder ring holes would no longer be needed when utilizing the overlying panel 16. There is simply no motivation to modify Drake

to provide an overlay, nor is there motivation to modify Fischer to provide for a pen-receiving hole.

To establish a case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings either in the references themselves or in the general knowledge available to one of ordinary skill in the art; second, there must be a reasonable expectation of success; third, the prior art reference or references must teach or suggest all the claim limitations. M.P.E.P. § 2143. It is, however, impermissible for the Examiner to use hindsight based on an Applicant's disclosure to determine that an Applicant's invention is obvious in view of the cited art. M.P.E.P. § 2142. The motivation or teaching to make the claimed combination by modifying or combining prior art references must be found in the prior art and not in the Applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Therefore, since there is nothing in Drake or Fischer to modify Drake to provide for an overlay, nor is there any motivation to modify Fischer to provide for a pen-receiving hole, the modification is not obvious. Accordingly, it is submitted that claim 1, as amended, patentably distinguishes over the relied upon portions of the cited references and is allowable.

Dependent claims 2-5 and new claim 11, which depend from independent claim 1, are believed to be similarly allowable.

In the event that the Examiner disagrees with any of the foregoing comments concerning the disclosures in the cited prior art, it is requested that the Examiner indicate where in the reference, there is the basis for a contrary view.

The Examiner has apparently made of record, but not applied, several documents. The Applicants appreciate the Examiner's implicit finding that these documents, whether considered

alone or in combination with others, do not render the claims of the present application unpatentable.

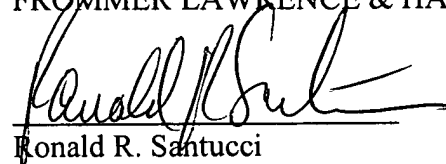
CONCLUSION

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable over the prior art, and early and favorable consideration thereof is solicited.

The Commissioner is authorized to charge any additional fee that may be required to Deposit Account No. 50-0320.

Respectfully submitted,
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